

REMARKS

Summary of the Office Action

In the Final Office Action dated July 3, 2003, claims 1-2 and 5 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by PCT International Application Publication No. WO99/12068 of Osa et al. (hereinafter Osa). Claim 3 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osa. Claims 6 and 10-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Summary of the Response to the Office Action

Applicant proposes to amend claims 6, 10-12 and 15-17 in accordance with the Office Action's indication of allowable subject matter in these claims. Applicant traverses the rejection of claim 5. Applicant proposes to cancel claims 1-3 without prejudice or disclaimer. Accordingly, 5-6 and 10-17 are presently pending in this application.

The Rejections of Claims 1-3

Claims 1-2 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Osa. Claim 3 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osa.

Applicant proposes to cancel claims 1-3 without prejudice or disclaimer. In light of this cancellation, the rejections of these claims are now moot. Accordingly, Applicant respectfully requests that the rejections of claims 1-2 under 35 U.S.C. § 102(b) and of claim 3 under 35 U.S.C. § 103(a) be withdrawn.

The Rejection of Claim 5 under 35 U.S.C. § 102(b)

Claim 5 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Osa.

Applicant traverses the rejection of claim 5 for the following reasons.

Independent claim 5 recites a stereomicroscope combination that includes an illumination unit including a shield element, a first condenser lens, and a second condenser lens with the following features:

said first condenser lens exhibits an optical characteristic of setting a position conjugate to an entrance pupil of said low-magnification objective lens fitted to said fitting member in a position of said shield element or in the vicinity of said shield element, said second condenser lens exhibits an optical characteristic of setting a position conjugate to an entrance pupil of said high-magnification objective lens fitted to said fitting member in a position of said shield element or in the vicinity of said shield element, wherein said shield element is disposed on a deflecting element for bending the optical axis, and said shield element has a cover member for covering a part of a deflecting surface of said deflecting element.

Applicant respectfully submits that Osa does not teach or suggests such features.

Applicant respectfully submits that in contrast to the instant invention, the optical system depicted in Fig. 39A of Osa is not related to an oblique illumination, but is directed to a dark field illumination, as described at column 7, line 40, and the discussion starting at column 24, line 6 of related U.S. Patent No. 6,396,628 B1 to Osa et al which is a continuation of Osa. Therefore, Applicant submits that the “shield element (435)” of Osa is for forming an annular or ring-shaped illumination whose diameter is larger than the numerical aperture NA of the objective lens (that is, an illumination with a larger diameter portion than an entrance pupil of the objective lens). Applicant submits that if a specimen is subjected to the ring-shaped illumination, observation of the specimen is made not directly by the illuminated light, but indirectly by scattered light or diffracted light.

On the contrary, Applicant respectfully submits that the “shield element” of the claimed invention has the purpose of obtaining an oblique illumination. In accordance with the illumination provided by the shield element of the claimed invention, the illumination light directed toward the specimen is directly observed through the objective lens (as indicated by the above-mentioned features of claim 5). When observing a specimen with the “shield element” of the claimed invention, the “shield element” is used for shading the image so that stereoscopic observation of the specimen may be achieved (as indicated by the above-mentioned features in claim 5). Moreover, the instant invention as recited in claim 5 of the present application is not related to observation of a specimen by dark field illumination.

In light of the following, Applicant respectfully submits that the “shield element” of the claimed invention and the “shield element (435) of the cited Osa reference are quite different in their optical function. Accordingly, Applicant respectfully asserts that Osa does not teach or suggest each feature of independent claim 5. Thus, Applicant respectfully submits that claim 5 is in condition for allowance as not being anticipated by Osa. Accordingly, Applicant respectfully requests that the rejection of claim 5 under 35 U.S.C. 102(b) be withdrawn.

The Allowable Claims

Claims 6 and 10-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant proposes to amend claims 6, 10-12 and 15-17 in accordance with the Office Action’s indication of allowable subject matter in these claims. Each of claims 6, 10-12 and 15-

17 is rewritten in independent form including all of the limitations of the corresponding base claim and any intervening claims.

Applicant respectfully submits that claims 6, 10-12 and 15-17 are in prima-facie condition for allowance in light of the Office Action's indication of allowable subject matter in these claims. Accordingly, Applicant respectfully requests that the objections to claims 6 and 10-17 be withdrawn.

Conclusion

In view of the foregoing, Applicant respectfully requests entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.


If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully Submitted,

MORGAN, LEWIS & BOCKIUS LLP

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By:


Baldine Brunel Paul
Registration No. 54,369

Customer No. 09629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, DC 20004
202-739-3000 (Phone)
202-739-3001 (Fax)